



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,222	03/13/2007	Chris Anthony Reed	K&C-177US	9351
23122	7590	03/23/2010		
RATNERPRESTIA P.O. BOX 980 VALLEY FORGE, PA 19482			EXAMINER PHAM, THOMAS K	
			ART UNIT	PAPER NUMBER
			2191	
			MAIL DATE	DELIVERY MODE
			03/23/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,222	Applicant(s) REED ET AL.	
	Examiner THOMAS K. PHAM	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/13/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant application having Application No. 10/585,222 filed on 03/13/2007 is presented for examination by the examiner.

Examiner Notes

2. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Oath/Declaration

3. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Priority

As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's claim for priority based on applications filed on January 06, 2004 (United Kingdom 0400148.3). Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. As required by M.P.E.P. 609, the applicant's submissions of the Information Disclosure Statement dated 03/13/2007 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The claim invention is not directed to eligible subject matter under 35 U.S.C. § 101 in view of **In Re Bilski**, 88 USPQ2d 1385. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing (See **In Re Bilski**, 88 USPQ2d 1385; see also **Diamond v. Diehr**, 450 U.S. 175, 184 (1981); **Parker v. Flook**, 473 U.S. 584, 588 n.9 (1978); **Gottschalk v. Benson**, 409 U.S. 63, 70 (1972); **Cochrane v. Deener**, 94 U.S. 780, 787-88 (1976)); The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter. The method claimed including "receiving a request for deployment", "maintaining registration information", and "invoking said function" are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any

Art Unit: 2191

transformation apparent; Therefore, the claimed invention is directed to non-statutory subject matter. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Claims 12-15, and 18 are rejected under 35 U.S.C. 101 as non-statutory for at least the reason stated above. Claims 14-19 are depended on claim 13, however, they do not add any feature or subject matter that would solve any of the non-statutory deficiencies of claim 13.

Claim 19 is rejected under 35 U.S.C. 101 as directed to non-statutory subject matter of software, *per se*. The claim lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. It is clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. It is at best, function descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Art Unit: 2191

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

In this case, applicant has claimed “a computer program” in the preamble to the claim. This implies that Applicant is claiming a system of software, per se, lacking the hardware necessary to realize any of the underlying functionality. Therefore, claim 19 is directed to non-statutory subject matter as computer programs, per se, i.e. the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2191

6. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (US 2002/0152260) (Hereinafter Chen).

Regarding claim 1

Chen teaches a software agent for representing a person's identity, the software agent being adapted to dock a dockable module, the dockable module comprising a method means for performing a function (see par. 45, an agent carrying seller functionality), wherein the software agent further comprises an intermodule communication means for mapping a request from a requesting module to the method means in the dockable module (see par. 31, inter-agent communication mechanism for communication with other agents, par. 23, the agents correspond to each of the business participants, par. 47, operation requests issued from a Web browser to a dynamic agent).

Regarding claim 11

Chen teaches a method of deployment of a module in an agent comprising the steps of: receiving a request for deployment of said module (par. 47, operation requests issued from a Web browser to a dynamic agent); maintaining registration information relating to a function supported by said module (see par. 47, the operation name and argument data can be sent in the body of the request); and invoking said function (see par. 51, Java objects are executable machine code that performs the program operations and functions).

Regarding claim 2

Chen teaches a software agent as claimed in claim 1 wherein, the method means is

Art Unit: 2191

adapted to perform said function responsive to said request (see par. 39, commands can be provided to control the actions of the agent).

Regarding claim 3

Chen teaches a software agent as claimed in claim 1, wherein said request from the requesting module comprises a label specifying a function and said method means in said dockable module corresponds to the specified function (see par. 35).

Regarding claim 4

Chen teaches a software agent as claimed in claim 1, wherein said intermodule communication means comprises a store of labels and associated modules (see par. 42).

Regarding claim 5

Chen teaches a software agent as claimed in claim 4 wherein said store of labels and associated modules is a table (see par. 57).

Regarding claim 6

Chen teaches a software agent as claimed in claim 1, wherein said method means is adapted to perform the function of docking said dockable module with said agent (see par. 51).

Regarding claim 7

Chen teaches a software agent as claimed in claim 1, wherein said method means is adapted to perform the function of registering a label with said intermodule communication means, the label specifying a function supported by said dockable module (see par. 54).

Art Unit: 2191

Regarding claim 8

Chen teaches a software agent as claimed in claim 1, wherein said method means is adapted to perform the function of undocking said dockable module from an agent (see par. 51).

Regarding claim 9

Chen teaches a software agent as claimed in claim 1, wherein said method means is adapted to perform the function of requesting to discard a label from the intermodule communication means, the label specifying a function supported by said dockable module (see par. 38).

Regarding claim 10

Chen teaches a software agent as claimed in claim 1, wherein said method means is adapted to perform the function of updating said dockable module within said agent (see par. 39, modification if needed).

Regarding claim 12

Chen teaches a method as claimed in claim 11, wherein, the step of maintaining registration information comprises maintaining a store of labels and associated modules, each label specifying a function supported by a module (see par. 42).

Regarding claim 13

Chen teaches a method as claimed in claim 12 wherein said store of labels and associated modules is a table (see par. 57).

Regarding claim 14

Chen teaches a method as claimed in claim 11, wherein, the step of maintaining

Art Unit: 2191

registration information comprises the step of registering a label specifying a function supported by said module (see par. 54).

Regarding claim 15

Chen teaches a method as claimed in claim 11, wherein, said module is a docked module and said step of maintaining registration information comprises the step of unregistering a label specifying a function supported by said docked module (see par. 38).

Regarding claim 16

Chen teaches a method as claimed in claim 11, wherein said module is a replacement module and said step of maintaining registration information comprises the steps of: unregistering a label specifying a function supported by a docked module from said agent (see par. 42); and registering a label specifying a function supported by said replacement module with said agent and said method further comprises the steps of: storing information related to a state of said docked module (see par. 46); and instantiating said replacement module using said stored information (see par. 51).

Regarding claim 17

Chen teaches a method as claimed in claim 16, wherein, said step of maintaining registration information comprises the step of queuing calls to the docked modules's registered labels, prior to the step of registering the label specifying the function supported by said replacement module (see par. 31).

Regarding claim 18

Chen teaches a method as claimed in claim 11, wherein, the function supported by said

Art Unit: 2191

module is the method of deployment of said module (see par. 39).

Regarding claim 19

Chen teaches a computer program comprising program instructions for causing a computer to perform the method of claim 11 (see rejection of claim 11 above).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas K. Pham whose telephone number is 571-272-3689. The examiner can normally be reached on Monday to Thursday 5:30 AM to 4:00 PM EST.

If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Wei Zhen, can be reached at the following telephone number: (571) 272-3708.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 23, 2010

Art Unit: 2191

/THOMAS K PHAM/
Primary Patent Examiner, Art Unit 2191